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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/545,381	04/07/2000	Craig Spielmann	JPM-001	2456
7590 12/27/2005			EXAMINER	
Andrew F Strobert Skadden Arps Slate Meagher & Flom LLP Four Times Square New York, NY 10036			VAN DOREN, BETH	
			ART UNIT	PAPER NUMBER
			3623	

DATE MAILED: 12/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/545,381

Applicant(s)

SPIELMANN ET AL.

Examiner

Beth Van Doren

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 10-15 is/are allowed.
- 6) ☒ Claim(s) 1,6-9,16 and 18 is/are rejected.
- 7) ☐ Claim(s) 2-5 and 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application on 11/10/2005. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/10/2005 has been entered.
2. Claims 1-18 remain pending in this application and are addressed below.

Allowable Subject Matter

3. Claims 10-15 are allowed.
4. Claims 2-5 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 6-9, 16, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buddle et al. (U.S. 6,912,502).

Art Unit: 3623

6. As per claim 1, Buddle et al. teaches a method for determining compliance with organizational business policies associated with a business risk, said method comprising:

- a. the computer receiving a user selection of a business risk element, said business risk element being retrieved from a database coupled to said computer (See figure 7, column 10, line 40-column 11, line 5 and lines 14-20 and column 13, lines 24-38, wherein the computer receives a compliance officer's selection of a risk element/compliance issue, which is retrieved and viewed from the database);
- b. in response to the selection of said business risk element, the computer retrieving one or more predetermined control procedures, the control procedures identified by an administrator as a means for complying with business policies associated with said selected risk element (See column 2, line 60-column 3, line 25 and lines 30-40, column 5, lines 15-30 and 44-60, column 11, lines 1-5, column 13, lines 25-40, wherein action plans (i.e. control procedures) associated with business policies and compliance issues are retrieved in association with the compliance issue. The action plan's purpose is to get the compliance issue to comply with policies and regulations);
- c. the computer associating said one or more predetermined control procedures with said selected business risk element, said predetermined control procedures being stored in said database (See column 5, lines 15-30 and 44-60, column 10, lines 30-55, column 11, lines 1-5, and column 13, lines 25-37, wherein the control procedures are stored and associated with the risk element);
- d. in response to the retrieving of the control procedures, the computer retrieving a weight assigned to each one of said predetermined control procedures, said weight being

Art Unit: 3623

stored in said database (See figure 4, column 8, lines 40-55, wherein a severity weight is assigned, which is retrieved and used to calculate overall risk);

- e. the computer receiving a user selection of a compliance rating for each said predetermined control procedure, the rating selected by the user indicating a level of compliance with each one of said predetermined control procedures, for each of said predetermined control procedures the level of compliance is a subjective rating selected from a rigid set of compliance ratings, the same set of compliance ratings is available for each of said predetermined control procedures (See figures 4 and 5A, column 7, lines 40-65, column 8, lines 32-55, wherein user selected ratings are provided to the control procedures, these indicating a level of compliance); and
- f. the computer calculating a compliance score, each compliance score being a function of said assigned weights and said compliance rating of said predetermined control procedures (See figure 4, column 5, lines 15-30 and 44-60, column 7, lines 30-40, column 8, lines 20-55, wherein a compliance score (risk score) is calculated by the system as a function of severity (weight) and the ratings).

However, Buddle et al. does not expressly disclose that the business risk element is selected from a business risk element list which is displayed to the user, said list being retrieved from a database coupled to said computer.

Buddle et al. discloses a database in the system that stores issues and actions plans and allows a user to retrieve and view the compliance issues and action plans from the database. Buddle et al. further discloses a display that is functionally connected to the input module, processor, database, etc. See figure 6. It is old and well known in software to display to a user a

Art Unit: 3623

list of files or data stored in a database when the user is trying to retrieve a file or data from said database, such as occurs when using the open function of a program. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to display a business risk element list to the user when the user is retrieving an element from the database in order to allow the user to more efficiently access the data stored in the database of the system by offering the user a more user-friendly display with which to interface the database.

7. As per claim 6, Buddle et al. discloses associating one or more parameters with each said compliance rating (See column 8, lines 20-40, column 11, lines 60-67, which discloses parameters associated with the compliance rating).

8. As per claim 7, Buddle et al. teaches wherein said one or more parameters are selected from the group comprising organization, business line, process, and region (See column 11, lines 60-67, which discloses such parameters).

9. As per claim 8, Buddle et al. teaches the step of the computer sorting said compliance scores by said one or more parameters (See column 11, lines 20-35 and line 60-column 12, line 5, which discloses sorting the scores).

10. As per claim 9, Buddle et al. teaches the step of the computer displaying said sorted compliance scores (See column 11, lines 20-35 and line 60-column 12, line 5 and lines 40-50, wherein reports are displayed).

11. Claim 16 is substantially similar to claim 1 and is rejected using the same art and rationale as applied above. Buddle et al. further teaches a database and a processor coupled to the database (See figures 6-7, column 12, lines 7-15 and 30-40, and column 13, lines 24-37).

Art Unit: 3623

12. As per claim 18, Buddle et al. teaches a data processing system further comprising a computer display coupled to said processor, said processor further being programmed to display said compliance scores on a computer display (See figures 6-7, column 7, lines 40-60, column 12, lines 1-15 and 30-49, and column 13, lines 24-37).

Response to Arguments

13. Applicant's arguments with respect to Buddle et al. (U.S. 6,912,502) have been fully considered.

Applicant's argument that Buddle et al. does not disclose a business risk element list that is displayed to the user, the list retrieved from a database (see page 3-4 of applicant's current remarks) has been fully considered and is persuasive. Therefore, the 35 USC § 102 rejection has been withdrawn. However, upon further consideration, a new grounds of rejection is made in view of Buddle et al. under 35 USC § 103.

Applicant's arguments that Buddle et al. does not teach or suggest (1) retrieving predetermined control procedures and (2) a weight assigned to a predetermined control procedure or retrieving this weight from the database have been fully considered, but they are not persuasive.

In response to argument (1), Examiner respectfully disagrees. The system of Buddle et al. receives a compliance officer's selection of a risk element/compliance issue, which is retrieved and viewed from the database. Action plans (i.e. control procedures) are associated with the compliance issues and reflect plans to achieve set business policies and regulations. A user has the ability to retrieve compliance issues and associated action plans from the data storage of the system in order to track and monitor the issues which face the business or

Art Unit: 3623

company. See column 2, line 60-column 3, line 25 and lines 30-40, column 5, lines 15-30 and 44-60, column 11, lines 1-5, column 13, lines 25-40.

In response to argument (2), Examiner respectfully disagrees. In the broadest reasonable interpretation of the term, a weight is a factor assigned to a number in a computation to make the number's effect on the computation reflect its importance. Buddle et al teaches assigning a severity score to an issue and its associated action plans (i.e. a business risk element and control procedures) in the computation of risk, the severity score being a value multiplied to reflect the severity of issue and action plans outcome (i.e. the degree to which something undesirable, such as fines, lawsuits, etc., may occur). The computation of risk is tracked, with the risk score being computed at intervals, such as predetermined intervals. All the information is stored in the database and retrieved to perform a current calculation. See column 8, lines 20-45, column 10, lines 30-55, and column 11, lines 1-5.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Aycock et al. (U.S. 5,675,138) discloses using control procedures to minimize risk and weighted scores.

Helzerman (U.S. 6,901,372) teaches potential failures and developing procedure to adjust potential failures using a control plan.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beth Van Doren whose telephone number is (571) 272-6737.

The examiner can normally be reached on M-F, 8:30-5:00.

Art Unit: 3623

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

bvd

bvd

December 20, 2005

Beth Van Doren
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Tech Center 3600
Patent Examiner